

## REMARKS

Claims 52-60 are pending in the present application. None of the claims were amended in this response.

Claim 55 was objected to for being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims.

Claims 52-58 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants traverse this rejection. Specifically, the Office Action argues that claim 52 defines a “system”, while the body of the claim recited software modules and as such is non-statutory. Applicants submit that there is no support whatsoever for this contention, either in case law or in the MPEP. Software and algorithmic processes, including software systems, have long been held as statutory subject matter (see MPEP 2106), and nothing was identified in the present claims that even remotely suggests otherwise. Applicants respectfully request the rejection be withdrawn.

Claims 52-54, 56-60 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ramous* (U.S. Patent 5,896,533) in view of *Rosen et al.* (U.S. Patent 5,991,802). Applicants respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

As was previously argued, regarding claim 52, *Ramous* does not teach “an object embedding program, implemented on a computer in said communications network, comprising a link to said network-based information provided by said one of said network servers and a link from which said object embedding program can locate said script program.” This feature is similarly claimed in claim 59 and 60. The Presentation Mechanism 304 of *Ramous* allows the OLE to link objects manufactured by OLE servers 302 (col. 4, lines 6-12). *Ramous* does not teach a link from which an object embedding program can locate said script program, because the Presentation Mechanism is always present between the container application and the OLE server (col. 4, lines 27-37). The Office Action dated June 27, 2005 has apparently conceded this point.

However, *Ramous* also does not teach the object embedding program “being structured to apply said script program to said network-based information so as to cause said data to be extracted from said network-based information” as recited in claim 52 (and similarly in claim 59 and 60).

Support for this feature may be found, for example, on page 22 of the present specification. In contrast, *Ramous* states that:

Presentation Mechanism 304 acts as an OLE surrogate server 308 and OLE surrogate container 310 for a WWW document. When a user activates an embedded WWW document, OLE surrogate server 308 calls Data Access Mechanism 306 to create a local copy of the WWW document referenced by OLE surrogate server 308, OLE surrogate server 308 then determines which server application should be activated based on the type of WWW document and activates the real OLE server 302

(col. 4, lines 17-25). *Ramous* further states that

Presentation Mechanism 304 acts as a conduit between the container application and the real OLE server 302 such that they communicate with one another as though the real OLE server 302's document is directly embedded in the real OLE container 300. Thus, although Presentation Mechanism 304 acts as both OLE server 302 and OLE container 300 via OLE surrogate server 308 and OLE surrogate container 310, to the real OLE container application 300, Presentation Mechanism object 304 appears as the real OLE server 302. Further, to OLE server 302, Presentation Mechanism object 304 appears as the real OLE container 300. Thus, Presentation Mechanism 304 intercedes in the normal operation of OLE such that it may replace the URL with local files that OLE server 302 may handle.

(col. 4, lines 26-39). Thus, the Presentation Mechanism 304 as disclosed in *Ramous* does not “extract data from network-based information provided by one of said network servers”, but instead replaces URLs with local files for the real OLE server to handle. In other words, the Presentation Mechanism does not “extract” anything, but instead passes embedded WWW documents with local copies made by the Data Access mechanism (see col. 5, lines 37-63). It is not understood how the “drag and drop” passage of col. 3, lines 50-55 relates at all to extracting data by a script program as recited in the present claims.

Next, the present invention claims an object embedding program, comprising “a link to said network-based information provided by said one of said network servers and a link from which said object embedding program can locate said script program.” The object embedding program is further structured to “apply said script program to said network-based information so as to cause

said data to be extracted from said network-based information, and to embed said data within a compound document implemented on a computer in said communications network.” These features are recited in claim 52 and similarly in claim 59 and 60.

In contrast, the Office Action cites a general passage about OLE applications (col. 3, lines 49-55, 60-67) to allege that the aforementioned features are disclosed. The passage in col. 6, lines 10-15 merely describes a document insertion dialog, where the Presentation Mechanism 304 may be registered to appear in a menu list as a “WWW Document”. Again, how this passage relates to the features discussed above is still not clear.

Applicants respectfully object to manner in which the present examination is being conducted. The above arguments have been repeatedly submitted in response to the Advisory Action dated October 19, 2004, pointing out clear and specific differences between the present claims and the cited *Ramous* reference. However, to date, the Office Actions have failed to provide any kind of rebuttal arguments to the specific arguments, but rather contain the same general rejection that has apparently been cut-and-pasted (at least since May 4, 2004). Furthermore, the last Office Action has introduced a new rejection based on 35 U.S.C. §101 almost two years after the first office action was mailed on the same claims. Applicants submit that such examination is improper.

The latest office action has now introduced the *Rosen* document as allegedly teaching the feature of an object embedding program locating a script program and being structured to apply the script program. While *Rosen* teaches the execution of a test script to test the interoperability of the container application programs and server application programs needed by the test script, *Rosen* merely teaches that the CreateObject function calls API functions to obtain an object from a server application and insert the object into a container application program (col. 35, lines 16-22). However, *Rosen* is completely silent regarding object embedding program being structured to apply the script program to the network-based information so as to cause said data to be extracted from the network-based information, and to embed the data within a compound document implemented on a computer in said communications network.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Ramous* and *Rosen* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532,

28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

As was mentioned previously, *Ramous* does not teach a link from which an object embedding program can locate said script program, because the Presentation Mechanism is always present between the container application and the OLE server (col. 4, lines 27-37). For what possible reason would one having ordinary skill in the art turn to *Rosen* "by allowing script program are written [sic] in order to correctly inserts [sic] and object from a server program into a container


application program” (see paragraph 7, page 4 of Office Action)? *Rosen* clearly discloses a test script being executed to test the interoperability of the container application programs and server application programs needed by the test script – this bears no relationship to the configuration disclosed in *Ramous* for accessing WWW files.

For at least these reasons, the Applicants submit that the §103 rejection is improper and should be withdrawn. Since claims 53-58 depend directly and indirectly from claim 52, it follows that these claims are allowable as well. Applicants earnestly request an early Notice of Allowance.

If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0115274-00005) on the account statement.

Respectfully submitted,

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Dated: September 27, 2005